

## REMARKS

Favorable reconsideration of this application is respectfully requested in view of the following remarks.

Claims 1-18 are pending in this application. Claims 1, 17 and 18 are the only independent claims.

The Office Action rejects Claims 1, 6-11, 17 and 18 under 35 U.S.C. §102(b), or alternatively under 35 U.S.C §103(a), over Junichi et al. ("Junichi"), JP 2000-346524. The rejections are improper and must be withdrawn for at least the following reasons.

Independent Claim 1 recites a wine storage apparatus comprising a wine storage compartment for storing wine, and a temperature control device for controlling a temperature of the wine storage compartment based on a target temperature. The temperature control device *repeatedly raises and lowers the target temperature* in the wine storage compartment in accordance with a preset cycle, a preset temperature band, and a preset variation pattern. Independent Claims 17 and 18 also recite wine storage apparatuses comprising a temperature control device that repeatedly raises and lowers a target temperature according to various presets.

Junichi does not disclose, and would not have rendered obvious, in combination with the other claimed features, a temperature control device that *repeatedly raises and lowers the target temperature* in the wine storage compartment in accordance with the claimed presets, as recited in independent Claim 1 and similarly recited in independent 17 and 18.

Junichi discloses a storage unit 1 including storing chambers 10-12 that are each equipped with a temperature regulating mechanism 20-22 (see Fig. 1 and Abstract). Wine 61 is stored in the storage unit 1 (see Fig. 1 and Abstract). Junichi

also discloses that each storing chamber 10-12 is set to a predetermined temperature having a specific value (see Abstract and paragraph [0026] of the computer generated English-language translation of Junichi). The specific value is a value in the range of 5 to 20°C (see Abstract and paragraph [0026]). The Office Action takes the position that each of the temperature regulating mechanism 20-22 corresponds to the claimed temperature control device, and that the predetermined temperature value corresponds to the target temperature.

However, Junichi discloses that the temperature of each storing chamber 10-12 is controlled to be **maintained** at the specific predetermined temperature value ("target temperature"), the value being one inside the range of 5 to 20°C (see paragraph [0026] of Junichi). Indeed, the Office Action states that it is at least inherent or obvious "to *attain or remain* around the target temperature" (see last line of page 2 of the Office Action, emphasis added). That is, Junichi's temperature regulating mechanisms 20-22 set the temperature in the storing chambers 10-12 to a *constant* temperature, being a predetermined value in the range of 5-20°C (see Abstract). If the temperature changes in response to fluctuations caused by, for example, opening the door 4 or other environmental conditions, the temperature regulating mechanisms 20-22 may raise or lower the temperature of the storing chambers 10-12 so that the temperature **returns** to the predetermined temperature value ("target temperature"). Accordingly, Junichi's temperature regulating mechanisms 20-22 *maintain* the predetermined temperature value ("target temperature") and may adjust the temperature so that the temperature *returns* to the predetermined temperature value. Junichi does not disclose repeatedly raising and lowering the specific *predetermined temperature value* ("target temperature") in the storing chambers 10-12. Thus, Junichi fails to disclose repeatedly *raising and*

*lowering the target temperature* in the wine storage compartment as recited in independent Claims 1, 17 and 18.

The Office Action further asserts that even if these claimed features are not disclosed, they are (1) inherent; or (2) at least would have been "an obvious choice" to one of ordinary skill in the art (see page 3 of the Office Action). Applicant respectfully disagrees with the these assertions.

With respect to (1), to establish inherency, the extrinsic evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference. Inherency, however, may not be established by probabilities or possibilities and the mere fact that a certain thing *may* result from a given set of circumstances is not sufficient to establish the inherency of that result (MPEP §2112 IV). That is, there can be no speculation or mere possibilities involved in a holding of inherency. What is alleged to be inherent must necessarily occur. Here, Junichi's temperature regulating mechanisms simply 20-22 *maintain* the predetermined temperature value ("target temperature") and may adjust the temperature so that the temperature *returns* to the predetermined temperature value, as discussed above. The temperature regulating mechanisms 20-22 do not repeatedly raise and lower *the predetermined temperature value* ("target temperature") in the storing chambers 10-12. Thus, the Office Action has not met its burden of making clear that the temperature regulating mechanisms 20-22 of Junichi necessarily repeatedly raise and lower the predetermined temperature value in the storing chambers 10-12

Moreover, the Office Action's position that the temperature regulating mechanisms 20-22 of Junichi repeatedly raise and lower the *predetermined temperature value* in the storing chambers 10-12 according to a preset cycle, a preset temperature band, and a preset variation pattern, is contrary to the teachings

of Junichi and the knowledge of the those skilled in the art of storing and aging wine at the time of the invention. As discussed in the present specification, it was commonly known to those skilled in the art to store wine at a *constant* temperature to avoid spoilage, and conventional wine cellars were provided with a temperature control function to prevent the temperature in a compartment from departing from a set temperature (see page 1, lines 9-17 and page 9, lines 4-7 of the specification). Indeed, Junichi teaches that the storing chambers 10-12 should be set at a constant temperature value, the value being one inside the range of 5 to 20°C (see Abstract and paragraph [0026] of Junichi). Thus, the Office Action's position that the claim features at issue here are inherent in Junichi is without factual support and is contrary to the teachings of Junichi and the knowledge of the those skilled in the art. Therefore, Junichi does not explicitly or inherently disclose all of the features recited in independent Claims 1, 17 and 18.

With respect to (2), it would not have been obvious to modify the temperature regulating mechanisms 20-22 of Junichi to repeatedly raise and lower the *predetermined temperature value* in the storing chambers 10-12.

First, there is inadequate evidence to support the Office Action's conclusion that it would have been obvious to one skilled in the art to modify the temperature regulating mechanisms 20-22 of Junichi to repeatedly raise and lower the *predetermined temperature value* in the storing chambers 10-12. The Office Action merely states that the modification would have been "an obvious choice . . . since the same feature is inherently present" (see page 3 of the Office Action). In one respect, this conclusory statement is legally incorrect. That a particular feature is inherent is not a proper basis for an obviousness rejection. Further, if that particular feature was in fact inherently present in a device, there would be no need for one skilled in

the art to modify the device to include the inherently present feature. In addition, the conclusory statement is insufficient to support an obviousness rejection, particularly taking into account the Patent Office's Examination Guidelines for Determining Obviousness Under 35 U.S.C. §103(a) in view of *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385 (2007). The Guidelines state that the Examiner should clearly articulate why the claimed invention would have been obvious. For example, the Supreme Court in *KSR* held that the Examiner "must [provide] some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" (*KSR*, 82 USPQ2d 1385, 1396 (2007)). In this case, it is not at all apparent why the stated modification would have been an "obvious choice" to an ordinarily skilled artisan, especially in view of the fact that it was common knowledge to those skilled in the art of wine storing and aging to store wine at a *constant* temperature to avoid spoilage. Thus, the Office Action fails to explain, with any articulated reasoning or rational underpinning, why it would have been obvious to modify the temperature regulating mechanisms 20-22 of Junichi to repeatedly raise and lower the *predetermined temperature value* in the storing chambers 10-12. Simply because something could have been modified and a person of ordinary skill was capable of making the modification does not mean it would have been obvious to do so. Thus, there is inadequate evidence supporting the conclusion that it would have been obvious to modify the temperature regulating mechanisms 20-22 of Junichi to repeatedly raise and lower the *predetermined temperature value* in the storing chambers 10-12, as recited in independent Claims 1, 17 and 18. The Examiner's statements in the third full paragraph on page 7 of the Office Action that *KSR* applies only when two or more prior art references are combined are without legal basis.

Moreover, modifying the temperature regulating mechanisms 20-22 of Junichi to repeatedly raise and lower the *predetermined temperature value* in the storing chambers 10-12, would not have been obvious because the modification is contrary to the teachings of Junichi and the conventional knowledge of the those skilled in the art of storing and aging wine. As discussed above, it was commonly known to those skilled in the art of storing and aging wine to store wine at a *constant* temperature to avoid spoilage, and conventional wine cellars such as Junichi's storage unit were provided with a temperature control function to prevent the temperature in a compartment from departing from a set temperature. One skilled in the art would not have been inclined to repeatedly vary the temperature of a Junichi's storage unit 1, as doing so would have resulted in spoilage of the wine based on the knowledge had by those skilled in the art at the time of the invention. That is, the stated modification would have rendered Junichi's wine storage unit 1 unsatisfactory for its intended purpose (MPEP §2143.01(V)). One skilled in the art would not have made such a modification of Junichi's wine storage unit 1. The Office Action fails to consider the references and claims as a whole and relies on impermissible hindsight using knowledge gleaned only from Applicant's disclosure (see MPEP §2145(X)(A)). Therefore, one skilled in the art would not have modified the temperature regulating mechanisms 20-22 of Junichi to repeatedly raise and lower the *predetermined temperature value* in the storing chambers 10-12 in accordance with the claimed presets as recited in independent Claims 1, 17 and 18. Thus, the combination of features recited in Claims 1, 17 and 18 would not have been obvious in view of Junichi. Accordingly, independent Claims 1, 17 and 18 are patentable over Junichi for at least these reasons.

Additionally, there is no evidence of record that Junichi discloses controlling the temperature of the storing chambers 10-12 according to a *variation pattern of multiple different temperature gradations* within a preset temperature band, as recited in independent Claim 18. Thus, independent Claim 18 is patentable over Junichi for at least these additional reasons.

Dependent Claims 6-11 are patentable over the applied references at least by virtue of their dependence from patentable independent Claim 1. Thus, a detailed discussion of the additional distinguishing features recited in these dependent claims is not set forth at this time. Withdrawal of the rejections is respectfully requested.

The Office Action rejects Claims 4, 5, 12, 13, 15 and 16 under 35 U.S.C. §103(a) over Junichi in view of Kawai et al. ("Kawai"), U.S. Patent No. 6,705,098; and rejects Claims 2 and 3 under 35 U.S.C. §103(a) over Junichi in view of Ishii et al. ("Ishii"), U.S. Patent No. 4,678,603, and Forino, U.S. Patent No. 4,842,869. The rejections are respectfully traversed.

Claims 2-4, 5, 12, 13, 15 and 16 are patentable over the applied references at least by virtue of their dependence from patentable independent Claim 1. Thus, a detailed discussion of the additional distinguishing features recited in these dependent claims is not set forth at this time. Withdrawal of the rejections is respectfully requested.

Should any questions arise in connection with this application or should the Examiner believe that a telephone conference with the undersigned would be helpful

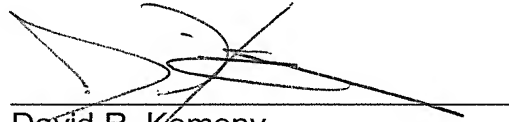
in resolving any remaining issues pertaining to this application the undersigned respectfully requests that he be contacted at the number indicated below.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

Date: May 19, 2009

By:

A handwritten signature in black ink, appearing to read 'David R. Kemeny', is written over a horizontal line.

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